

REMARKS

1. In response to paragraph 1 of the Office Action, Applicant acknowledges and appreciates Examiner's acceptance, and consequential withdrawal, of the Office's rejections to Applicant's claims 22-40.
2. In response to paragraph 2 and 3 of the Office Action, Applicant acknowledges Examiner's rejection under 35 U.S.C. § 101 of claims 37-40. Applicant adopts the amendments to claims 37-40 kindly suggested by the Office. Accordingly, Applicant requests entry of these amendments and withdrawal of the § 101 rejections of claims 37-40.
3. In response to paragraph 4 of the Office Action, Applicant acknowledges Examiner's rejection of claims 22-40 under 35 U.S.C. § 102 (e) as being anticipated by Marchionda, U.S. Pat. No. 6,628,306 ("Marchionda"). Applicant amends and objects with traverse to Marchionda anticipating Applicant's claims 22-40. Applicant's proposed claim amendments do not add any new matter, and are supported by the specification.

For a claim to be anticipated, Marchionda must describe each element and limitation of that claim.¹ Further, Marchionda "must also enable one of skill in the art to make and use the claimed invention."² Below, Applicant provides reasons why Applicant's independent claim 22, and, by analogy, independent claims 30 and 37, are not anticipated by Marchionda as a matter of law.

Amended claim 22 states:

A method in a data processing system for selectively transmitting an email attachment of an email, the method comprising:

selecting, by a sender, email attachment recipients, selectable notification recipients, and excluded recipients for the email to be sent, wherein the excluded recipients do not receive the email attachment;

¹ *C.R. Bard, Inc. v. M3 Systems, Inc.*, 157 F.3d 1340, 1349 (Fed. Cir. 1998); *Celeritas Techs. Ltd. v. Rockwell Int'l. Corp.*, 150 F.3d 1354, 1360 (Fed. Cir. 1998).

² *Bristol-Myers Squibb Co. v. Ben Venue Laboratories, Inc.*, 246 F.3d 1368, 1374 (Fed. Cir. 2001)(quoting *In re Donohue*, 766 F.2d 531, 533 (Fed. Cir. 1985).

receiving, from the sender, an instruction to add a selectable notification for the email attachment to the email to be sent to the selectable notification recipients;

transmitting the email to the email attachment recipients, the email with the selectable notification to the selectable notification recipients, and the email to the excluded recipients; and

whereby, activation of the selectable notification associated with the email permits transmission of the email attachment.

Unlike Applicant's claims, Marchionda does not describe Applicant's first claim element and limitation of "selecting ... selectable notification recipients." Nowhere in Marchionda, including specifically at the Office's cited sections thereof, is there any description remotely related to "selectable notification recipients" or even a "selectable notification" as further discussed below.

Building on the foregoing reason, nowhere does Marchionda describe Applicant's second claim element and limitation of "receiving, from the sender, an instruction to add a selectable notification for the email attachment to the email to be sent to the selectable notification recipients." Respectfully, Applicant disagrees with the Office that Marchionda at abstract and col. 4, ll. 51-62 teaches Applicant's second element, and with the Office's statement: "note the different options built from instructions that is the makeup of the selectable notification." Applicant disagrees because, at the cited sections, Marchionda describes "the email system drives the display" "to invite the user to select between at least the functions of sending the email message" with or without the email attachment. Here, Marchionda does not describe Applicant's claim limitations of "to add a selectable notification for the email attachment to the email to be sent to the selectable notification recipients." Instead, Marchionda merely describes utilizing a functionality, i.e., selecting, associated with the email client's application: selecting cc: recipients that will or will not receive the email attachment with the email. Unlike Applicant's claimed invention, however, Marchionda completely fails to describe *adding something else*, i.e., adding "a selectable notification," a real item, to an email. Furthermore, Marchionda does not describe adding this "selectable

notification” *only* for certain email recipients, namely Applicant’s claimed “selectable notification recipients.”

Applicant notes that the claim amendments’ whereby clauses state a goal of the invention, and neither change the substance of the invention nor merely state the intended result of a positively recited process.³ Instead, the whereby clauses state conditions material to patentability through its limitations, which are integral to patentability and claim construction.⁴ Marchionda does not describe these limitations.

For any of the above-stated reasons, Marchionda fails to describe all of Applicant’s claim elements and limitations limitations for Applicant’s claim 22, as well as Applicant’s other independent claims 30 and 37 under the same analogy also used by the Office. Accordingly, any and all claims depending from independent claims 22, 30, and 37 are also not anticipated as a matter of law.⁵ Therefore, Applicant respectfully requests withdrawal of all claim rejections under § 102 (e) as a matter of law.

³ *Hoffer v. Microsoft Corp.*, 405 F.3d 1326, 1329, 74 USPQ2d 1481, 1483 (Fed. Cir. 2005), the court held that when a “whereby” clause states a condition that is material to patentability, it cannot be ignored in order to change the substance of the invention.”

⁴ *Id.*, (citing *Minton v. Nat'l Ass'n of Securities Dealers, Inc.*, 336 F.3d 1373, 1381, 67 USPQ2d 1614, 1620 (Fed. Cir. 2003) (a “whereby clause in a method claim is not given weight when it simply expresses the intended result of a process step positively recited.”)

⁵ *Id.; In re Fine*, 837 F.2d 1071, 1076 (Fed. Cir. 1988)(if independent claim is allowable, then so are the dependent claims).

CONCLUSION

Based on the foregoing, Applicant respectfully submits that the instant application is in condition for allowance. Applicant invites the Office to freely reach Applicant's attorney using the contact information found in his signature block below.

No fee is believed due with this paper. However, if any fee is determined to be required, the Office is authorized to charge Deposit Account 09-0447 for any such required fee.

Respectfully submitted,

Date: January 2, 2009 _____
/Erik J. Osterrieder/
Erik J. Osterrieder
Reg. No. 48,966
Schubert Osterrieder & Nickelson PLLC
6013 Cannon Mtn. Dr., S14
Austin, TX 78749
Tel: (713) 533-0494
Fax: (512) 301-7301
E-mail: ejo@sonlaw.com
ATTORNEY FOR APPLICANT/ASSIGNEE